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In re Application of	:	
KLOKKERS et al.	:	
Application No.: 10/577,569	:	
PCT No.: PCT/EP2004/012230	:	
Int. Filing Date: 28 October 2004	:	DECISION
Priority Date: 31 October 2003	:	
Attorney Docket No.: 930008-2208	:	
For: PHARMACEUTICAL ACTIVE-INGREDIENT-	:	
CONTAINING FORMULATION WITH COATING	:	

This decision is in response to the petition under 37 CFR 1.47(a) filed 04 October 2007 in the United States Patent and Trademark Office (USPTO).

BACKGROUND

On 28 October 2004, applicants filed international application PCT/EP2004/012230, which designated the United States and claimed a priority date of 31 October 2003. A copy of the international application was communicated from the International Bureau to the USPTO on 12 May 2005. The thirty-month period for paying the basic national fee in the United States expired at midnight on 01 May 2006 (30 April 2006 being a Sunday).

On 27 April 2006, applicants filed a submission for entry into the national stage in the United States which was accompanied by, *inter alia*, the U.S. Basic National Fee and a translation of the application into English.

On 26 August 2005, the United States Designated/Elected Office (DO/EO/US) mailed a NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating, *inter alia*, that an oath or declaration of the inventors in compliance with 37 CFR 1.497(a)-(b) was required.

On 21 February 2007, applicants filed a petition under 37 CFR 1.47(a) which was accompanied by, *inter alia*, a declaration signed by all of the inventors except for Thomas Rillmann, a letter from a Dr. Forstmeyer to Applicant's United States attorney, Ms. Massey Licata, dated 20 February 2007.

On 28 March 2006, a decision was mailed dismissing applicants' petition under 37 CFR

1.47(a) without prejudice. The decision indicated, *inter alai*, that applicant had failed to provide factual proof that the missing joint inventor refuses to execute the application or cannot be reached after diligent effort. The decision set a two-month extendable period for reply.

On 17 July 2007, applicants filed a submission which was accompanied by, *inter alia*, a declaration of inventors signed by Thomas Rillmann.

On 05 September 2007, a decision was mailed dismissing applicants' petition under 37 CFR 1.47(a) as moot since a 37 CFR 1.497 declaration had been executed by all the joint inventors. The decision also indicated that the declaration of inventors signed by Thomas Rillmann filed 17 July 2007 was not in compliance with 37 CFR 1.497(a)-(b) since it did not identify all of the inventors and that a new declaration signed by Thomas Rillmann in compliance with 37 CFR 1.497(a)-(b) was required.

On 04 October 2007, applicants submitted the instant petition under 37 CFR 1.47(a), which was accompanied by, *inter alai*, a declaration of facts by Hubert Leger.

DISCUSSION

A petition under 37 CFR 1.47(a) must be accompanied by: (1) the fee under 37 CFR 1.17(h); (2) factual proof that the missing joint inventor refuses to execute the application or cannot be reached after diligent effort; (3) a statement of the last known address of the missing inventor; and (4) an oath or declaration by each 37 CFR 1.47(a) applicant on his or her own behalf and on behalf of the non-signing joint inventor.

Items (1), (3), and (4) have been met.

Item (2) has not been satisfied. MPEP § 409.03(d) states in part:

A refusal by an inventor to sign an oath or declaration when the inventor has not been presented with the application papers does not itself suggest that the inventor is refusing to join the application unless it is clear that the inventor understands exactly what he or she is being asked to sign and refuses to accept the application papers.

The declaration of facts by Mr. Leger filed 04 October 2007 makes it clear that Mr. Rillmann understands exactly what he is being asked to sign. However, it has not been established that Mr. Rillmann refuses to sign. While Mr. Rillmann signed a declaration of inventors listing only himself as an inventor, it has not been established that he refuses to sign a declaration of inventors listing all of the inventors. The declaration of Mr. Leger states that a facsimile was sent to Mr. Rillmann's attorney on 02 October 2007 informing him of the problem with the declaration executed by Mr. Rillmann and requesting that Mr. Rillmann return an executed version of the original declaration before 04 October 2007. However, two days is not a sufficient amount of time for a reply. If no response is received from Mr. Rillmann's attorney, some sort of follow-up communication would be required. Additionally, the statement of facts is not

sufficient because it must be made by someone having first-hand knowledge of the facts recited therein. MPEP § 409.03(d). Mr. Leger does not appear to have first-hand knowledge of all of the facts recited. For example, someone other than Mr. Leger sent the facsimile to Mr. Rillmann's attorney on 02 October 2007.

CONCLUSION

For the above reasons, applicants' petition under 37 CFR 1.47(a) is **DISMISSED** without prejudice.

For the above reasons, that portion of the decision mailed 05 September 2007 which dismissed applicants' petition under 37 CFR 1.47(a) as moot is hereby **VACATED**.

If reconsideration on the merits of this petition is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. **Failure to timely file the proper response will result in abandonment of this application.** Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)". No additional petition fee is required. Extensions of time may be obtained under 37 CFR 1.136(a).

Please direct further correspondence with respect to this matter to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



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